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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/769,688   | 01/25/2001  | Takashi Mochizuki    | P/647-136           | 5364             |
| 32172  | 7590        | 03/29/2005           | EXAMINER            |                  |
| DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP<br>1177 AVENUE OF THE AMERICAS (6TH AVENUE)<br>41 ST FL.<br>NEW YORK, NY 10036-2714 |             |                      | KUMAR, PANKAJ       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2631                |                  |

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                 |                    |  |
|---|-----------------|--------------------|--|
| <b>Advisory Action</b><br><b>Before the Filing of an Appeal Brief</b> | Application No. | Applicant(s)       |  |
|   | 09/769,688      | MOCHIZUKI, TAKASHI |  |
|   | Examiner        | Art Unit           |  |
|   | Pankaj Kumar    | 2631               |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 3 and 4.

Claim(s) rejected: 1, 2 and 5-10.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

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Applicant argues that since the duplexer is isolating, it is not attenuating since one would not equate isolating function of a duplexer with an attenuator. This is not persuasive. Even though the duplexer in Bradley is trying to isolate, it can only provide a little bit of attenuation initially before providing enough attenuation for isolation. This is shown in Bradley's figs. 1 and 2. Figure 1 shows duplexer 20 which has bandpass filters 30 and 32. The filters are attenuating at various frequencies. From Bradley in the discussion of figure 2, "The required characteristics of the band-pass filters 30 and 32 are shown at 36 and 38, respectively." As shown in fig. 2, 36 initially at a lower frequency shows a low amount of attenuation such as 1 dB, 2 dB or 10 dB and then at a higher frequency, it shows a higher attenuation of 40dB and slightly less than 50dB.

Applicant argues that Bradley does not disclose a second attenuation amount. This is not persuasive since applicant claims "or a second attenuation amount". Hence, the claim can be taught by either the limitation preceding the "or" statement or the limitation after the "or" statement. It was shown in prior action(s) how the reference(s) teach the limitation preceding the "or" statement.

Applicant argues that it does not make logical sense for Bradley's filters that are configured to be controlled since the Bradley does not teach "means of controlling the filters whereby the filter response can be changed during operation" (applicant's argument page 4). This is not persuasive since applicants have not claimed 'means of controlling the filters whereby the filter response can be changed during operation'.

Applicant argues that the examiner has stated that Bradley teaches adjustable filter. This is not persuasive since the examiner stated that Bradley did not teach adjustable filter but Katayama did teach adjustable filter (action mailed 1/24/2005 page 3 paragraph 7).

Applicant argues that the first and second attenuation amounts cited in Bradley are not what the applicant has claimed with its first and second attenuation amounts since Bradley has first and second attenuation amounts for distinct passbands while applicant has attenuation amounts outside of the transmission signal band. This is not persuasive. Applicant's first and second attenuation amounts are not claimed to be outside of the transmission signal band.

Applicant argues that Bradley does not teach control means for setting one of first and second attenuation amounts. The office recited on pages 5-6 paragraph 13 of the prior action that Katayama taught such a feature.

Applicant argues that Bradley and Katayama cannot be combined because Katayama suggests a variable design and Bradley teaches that the filters are designed in a specific manner such that the passband and the stop band overlap and thus does not suggest a variable design. This is not persuasive. First Bradley does not suggest only one design since it teaches various types of communication systems and has illustrative examples while also stating that "various modifications may be practiced". Second, if the transmit and receive bands move in Bradley, such as when Bradley is used in a noisy environment where the amount of spread of the

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transmit and receive bands change in frequency, it would be advantages for Bradley's system to change the locations of the passband and stop band and thus change where the overlap occurs so that good quality transmission and reception can still occur in Bradley.

TESFALDEY BOZIRE  
PRIMARY EXAMINER